

**REMARKS**

Claims 10-12, 16-19, 23, 24, and 41-52 are currently pending. By this Amendment, claim 43 has been cancelled and new claim 53 has been added. Thus, claims 10-12, 16-19, 23, 24, 41, 42, and 44-53 are currently at issue.

**I. Rejections Under 35 U.S.C. § 103**

In Paragraph 2 of the Office Action, the Examiner rejected claims 10-12, 16-19, 23-24, and 41-52 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's disclosure at page 1, lines 5-24 and FIGS. 1 and 7, in view of U.S. Patent No. 5,181,357 to Pourtau et al. ("Pourtau"). Applicant respectfully traverses these rejections.

**A. Claims 10-12, 16-19, 23-24, and 44-52**

No prima facie case of obviousness has been established with respect to claims 10-12, 16-19, 23-24, and 44-52 because Pourtau cannot properly be combined with Applicant's disclosure to form an obviousness rejection of the present claims. More specifically, Pourtau is non-analogous art with respect to the present Application. Regarding non-analogous art, the Federal Circuit has stated:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)

Pourtau is non-analogous art because it is not in the field of Applicant's endeavor and is not reasonably pertinent to the problem with which the invention is concerned.

Pourtau is not in the field of Applicant's endeavor because Pourtau does not disclose or discuss the use of the device in connection with a window or window assembly, which is the field of Applicant's invention. Rather, Pourtau deals with floors and floor coverings, and persons skilled in the art of designing windows and window assemblies cannot be expected to also be familiar with flooring and floor covers.

Pourtau also is not pertinent to the problem with which Applicant's invention is concerned. The specification of the present Application identifies several benefits achieved by the present invention, and by the use of the textured surface on the muntin clip. For example, the textured surface serves to frictionally engage the pane separator, in order to more securely hold the muntin clip and the pane separator together. This function is further recited in the claims of the present Application (e.g., in claim 10: "the textured surface adapted to frictionally engage the separator"). However, the ridges discussed in Pourtau do not serve to provide friction between mating surfaces, contrary to the Examiner's assertion in the Office Action. Rather, the ridged surfaces in Pourtau (1A, 1B, 2B) are in contact with an adhesive mortar (8). While Pourtau does not describe the function of these ridged surfaces (1A, 1B, 2B), it would appear that they function to provide greater surface area for contact with the adhesive (8), rather than frictional engagement. In fact, Applicant notes that frictional engagement is not necessary with the use of the adhesive, because the adhesive serves the function of securing separate parts together. Thus, Pourtau is not related or pertinent to the problem with which Applicant's invention is concerned, and Pourtau is non-analogous art. Accordingly, because the cited references cannot be properly combined to form an obviousness rejection of the present claims, no prima facie case of obviousness has been established with respect to claims 10-12, 16-19, 23-24, and 44-52.

#### **B. Claims 41-42**

Claim 41 includes, among other elements, "each protrusion having a length, a width, and a height that are substantially smaller than a length, a width, and a thickness of the lip." The Examiner cites Pourtau as disclosing this element. However, Pourtau not disclose, teach, or suggest this feature of claim 41. The surface protrusions pointed to by the Examiner on surface 2B of the strip of Pourtau are "striae over the whole of its length and height." (Col. 3, Lns. 50-52). In other words, these striae are ridges that extend the *entire width* of surface 2B. However, claim 41 recites that the width of the protrusions are "substantially smaller than ... a width ... of the lip." The striae/ridges disclosed by Pourtau do not meet this element of claim 41, and thus,

the cited references do not disclose, teach or suggest this element. Accordingly, no prima facie case of obviousness has been established with respect to claim 41.

Claim 42 depends from claim 41 and includes all the elements thereof. Thus, for the same reasons stated above with respect to claim 41, no prima facie case of obviousness has been established with respect to claim 42.

Additionally, as stated above with respect to claims 10-12, 16-19, 23-24, and 44-52, the cited references cannot be properly combined to form an obviousness rejection, because Pourtau is non-analogous art to the present invention. Thus, for this additional reason, no prima facie case of obviousness has been established with respect to claims 41 and 42.

## **II. New Claim**

New claim 53 has been added to the present Application by this Amendment, and claim 53 is patentable over the cited references. Claim 53 depends from claim 10, and thus, is patentable over the cited references for the same reasons stated above with respect to claim 10. Additionally, claim 53 includes the element, "each protrusion has a length, a width, and a height that are substantially smaller than the length and the width of the textured surface." This element is similar to the element discussed above with respect to claim 41, and for the same reasons stated above, the cited references do not disclose, teach, or suggest this element of claim 53. Accordingly, for at least these reasons, claim 53 is patentable over the cited references, and Applicant respectfully requests allowance thereof.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of Claims 10-12, 16-19, 23, 24, 41, 42, and 44-52 in the present Application. Applicant also requests examination and allowance of new claim 53 in the present Application. Applicant submits that the Application is in condition for allowance and respectfully requests an early notice of the same.

Please charge any necessary fees to our Deposit Account No. 19-0733.

Respectfully submitted,

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